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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/882,197 06/25/97 GREER

P 42390.P4072

EXAMINER

TM02/1106

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ART UNIT

PAPER NUMBER

2163

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/882,197

Applicant

Greer et al.

Examiner
Susanna M. Díaz

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2163



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 10, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-57 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. This office action is responsive to Applicant's amendment filed August 10, 2001.

Claims 46-57 have been added.

Claims 1-14 and 16-57 are pending.

2. The previous 101 rejection is withdrawn in response to Applicant's amendment.

The previous 112, 2nd paragraph rejection is withdrawn in response to Applicant's amendment.

The previous 102 and 103 rejections over Davies et al. (WO 96/23265) are withdrawn.

Response to Arguments

3. Applicant's arguments filed August 10, 2001 have been fully considered but they are not persuasive.

Applicant argues:

“The Dedrick reference discloses a method and apparatus for storing and undating [sic] electronic information in a personal content provider (27) for an individual user (12) (see Figures 1 and 2). The personal content provider is part of a server belonging to the target computer of the individual user. As such, the Dedrick reference does not disclose or suggest a content provider coupled to the target computer via a network as recited in claim 1.” (Page 10 of Applicant's amendment)

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The Examiner respectfully disagrees. Dedrick discloses a metering service which is couple to a local area network (col. 3, lines 6-26). End user profile data is uploaded to the metering server (Figure 3a; col. 4, lines 4-8; col. 9, lines 57-65). In one embodiment, the metering server has control over which content is delivered to the end user:

“In one embodiment, requests for information are made by the appraisal agent 28. In this embodiment, the metering process 36 checks whether the content database 34 contains information matching the search criteria provided by the appraisal agent 28. If a match exists, then electronic information is returned to the client system 12, provided the end user which initiated the appraisal agent 28 is a subscriber of the information, or has a sufficient balance in his or her account to pay for the electronic information.” (col. 10, line 62 through col. 11, line 33)

Applicant argues:

“Furthermore, claim 46 describes the first agent being an object code for a control residing on a web page. In the cited references (Dedrick and Davies et al.), the agent residing in [sic] the user. As such, the cited references do not disclose or suggest the first agent being an object code for a control residing on a web page as recited in claim 46. Claim 49 describes the target computer communicating with additional content providers, and the target computer maintains several rule pages of the additional content providers. Each provider rule page includes information from at least one of the additional content providers. The cited references do not disclose or suggest each provider rule page including information from at least one of the additional content providers as recited in claim 49.” (Page 11 of Applicant’s amendment)

This argument is addressed in the art rejection below since claims 46-57 are newly added claims.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 29-31, and 38-45 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dedrick (U.S. Patent No. 5,710,884).

As in the claimed invention, Dedrick teaches the use of agents to proactively target users with advertisements that would likely be of interest to the users (as judged based on the user's updated profile). See at least col. 9, lines 3-46. It should also be noted that condition-action pair rules are inherent for the targeting of advertisements to occur. For example, such rules must incorporate logic along the lines of, "If user A has characteristic X, then send user A advertisement B." This is an example of a condition-action pair rule.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 3, 4, 9-11, 17-20, 23-26, 28, 32-37, and 46-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (U.S. Patent No. 5,710,884), as applied to claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 29-31, and 38-45 above.

While Dedrick discloses the targeting of different information based on various rules applied to a user's profile, Dedrick does not explicitly outline every rule permutation possible. Claims 3, 4, 9-11, 17-20, 23-25, 28, and 32-34 and 37 merely address the characteristics of the target computer. Artisans of ordinary skill in the art have long known that it is common to collect data regarding a computer user's hardware and software in order to gather information about a computer user's hardware and software interests as well as to assist in establishing effective computer communications. For example, certain network protocols may need to be established for data transmission depending on a user's particular computer characteristics, including memory usage, memory available, processor clock speed, operating system, modem speed, software, etc. As a matter of fact, a user's Internet and/or general networking capabilities are dependent on each of these factors; therefore, certain software may not even be compatible with the user's computer system. As a result, it would be a waste of time to attempt to download or even market products that are incompatible with a user's computer system to that particular user. Consequently, it would behoove an agent to be programmed to retrieve data regarding said hardware and software characteristics in order to effectively assess which information is to be targeted to which users, thereby making such an enhancement to Dedrick's invention obvious to one of ordinary skill in the art at the time of Applicant's invention.

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As per claims 26, 35, and 36, while Dedrick gathers information concerning web sites visited by a user, he does not explicitly disclose that he records the time spent by the user at each web site; however, the Examiner asserts that such a limitation would be deemed obvious in light of the fact that artisans of ordinary skill in the art have long been aware of the correlation between a user's interest in a given topic and the time the user spends researching that topic. Therefore, the longer a user spends at a given web site, the more interest the user likely has in the information related with that particular web site. Consequently, an artisan of ordinary skill in the art at the time of Applicant's invention would have found it obvious to not only record information concerning the web sites visited by a user, but also to record the time spent at each web site in order to enable more effective targeting of information to a user based on a more accurate analysis of that user's interests.

As per claims 46, 47, 50, 51, 54, and 55, while Dedrick's agents collect profile information through a local area network (LAN) or a wide area network (WAN), Dedrick fails to explicitly disclose the collection of profile information through a web page via the Internet. However, the Examiner asserts that it is old and well-known in the art to collect profile information through a web page via the Internet. As a matter of fact, wide area networks are commonly implemented through the Internet in order to facilitate global connections. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Dedrick's agents to collect user profile information through a web site via the Internet in order to facilitate data collection from users throughout the world. All of the limitations of

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claims 46, 47, 50, 51, 54, and 55 are inherent to this Internet-enable version of Dedrick's invention.

Regarding claims 48, 49, 52, 53, 56, and 57, Dedrick fails to disclose multiple content providers. However, Dedrick's system profits, at least in part, from its ability to charge for delivering targeted content to an end user; therefore, the more content providers there are available, the more likely Dedrick's system is to be profitable. Since different content providers likely provide different content services, the associated rule pages would be customized to each content provider based on information received from each of these content providers. As a result, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement Dedrick's invention with multiple content providers such that each provider is associated with a respective rule page based on information from each content provider in order to widen Dedrick's market thereby increasing potential for profit while meeting the specific marketing needs of each content provider.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for Official communications, (703) 746-7240 for Non-Official communications, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 or to the Customer Service Office on (703) 306-5631.

SMD

November 5, 2001


Kyle Choi
Patent Examiner
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